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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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EXAMINER

CHEN, V

ART UNIT

PAPER NUMBER

1773

DATE MAILED:

06/19/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/485,002

Applicant(s)

NAKATA et al

Examiner

Vivian Chen

Art Unit

1773



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 1-30-00
- 2a) This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-67 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) \_\_\_\_\_ is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 1-67 are subject to restriction and/or election requirement.

## Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved.
- 12) The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) All b) Some\* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- |    |   |    |   |
|----|---|----|---|
| 15 | Notice of References Cited PTO-892                      | 18 | Interview Summary PTO-413 Paper No. s         |
| 16 | Notice of Draftsperson's Patent Drawing Review PTO-948  | 19 | Notice of Informal Patent Application PTO-152 |
| 17 | Information Disclosure Statement s PTO-1449 Paper No. s | 20 | Other   |

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***Restriction***

1. This restriction requirement has been provided in writing due to its complexity.
2. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-17, drawn to a first biodegradable polyester composition and articles thereof.

Group II, claim(s) 18-24, drawn to a biodegradable card.

Group III, claim(s) 25-29, drawn to a first biodegradable laminate.

Group IV, claim(s) 30-35, drawn to a second biodegradable laminate.

Group V, claim(s) 36-42, drawn to a third biodegradable multilayer film.

Group VI, claim(s) 43-47, drawn to a biodegradable film.

Group VII, claim(s) 48, drawn to an cushion material with a first base film.

Group VIII, claim(s) 49-52, drawn to a cushion material with a second base film.

Group IX, claim(s) 53-58, drawn to particles with a first biodegradable coating.

Group X, claim(s) 59-62, drawn to particles with a second coating.

Group XI, claim(s) 63-67, drawn to a biodegradable resin composition.

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3. The inventions listed as Groups I-IX do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The common feature in these claims is the use of a layer containing a polycaprolactone material, which is known in the art (see KURODA ET AL. in the IDS filed 9/20/2000) and therefore does not meet the requirement of a "special technical feature" as required for unity of invention. Since the common feature to the inventions has been shown not to be unique over the prior art, restriction of examination to one of the above groups is proper.

4. The inventions listed as Groups I-III, V-IX, XI do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The common feature in these claims is the use of a layer containing an composition containing mixture of aliphatic polyester and a polycaprolactone material, which is known in the art (see KURODA ET AL. in the IDS filed 9/20/2000) and therefore does not meet the requirement of a "special technical feature" as required for unity of invention. Since the common feature to the inventions has been shown not to be unique over the prior art, restriction of examination to one of the above groups is proper.

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5. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vivian Chen whose telephone number is (703) 305-3551. The examiner can normally be reached on Monday-Thursday from 8:30 AM to 6:00 PM and on alternate Fridays from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Paul Thibodeau, can be reached on (703) 308-2367.

For Art Unit 1773, the fax phone numbers are as follows:

official faxes:

(703) 305-3601

(703) 305-7718

unofficial faxes:

(703) 305-5436

(703) 305-3602

Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1700 receptionist whose telephone number is (703) 308-0661.

VC

June 18, 2001

  
Vivian Chen  
Primary Examiner  
Group 1700